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U.S. Application No. 09/923,320 Examiner Nguyen, Art Unit 2154
Notice of Appeal and Pre-Appeal Brief Request for Review in Response to May 9, 2006 Final Office Action

PRE- APPEAL BRIEF REQUEST FOR REVIEW

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In response to the Final Office Action mailed May 9, 2006, the Assignee requests a Pre-Appeal Brief Review of the previously-identified patent application in view of the following remarks. No amendments are being filed with this request, and this request is being filed concurrently with a Notice of Appeal.

REMARKS

In the final office action, claims 1, 7-20, 24-30, 34-40, 42, 44, and 46-48 were finally rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,564,261 to Gudjonsson *et al.* Claims 3-4, 21-22, 31-32, and 45 were finally rejected under 35 U.S.C. § 103 (a) as being obvious over Gudjonsson in view of U.S. Patent 6,021,433 to Payne *et al.* Claims 5-6, 23, 33, 41, 43, and 51-54 were finally rejected as being obvious over Gudjonsson in view of U.S. Patent 6,763,384 to Gupta *et al.* The Assignee respectfully submits that the pending claims already distinguish over the cited documents.

The Assignee requests a panel review for the reasons stated below.

1. **Because *Gudjonsson* Is Entirely Silent to Many Claimed Features, *Gudjonsson* Cannot Anticipate the Pending Claims**

Claims 1, 7-20, 24-30, 34-40, 42, 44, and 46-48 were finally rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent 6,564,261 to Gudjonsson *et al.* These claims, however, recite or incorporate features that are not disclosed by *Gudjonsson*. All the independent claims, for example, recite “*monitoring a total number of users who log in to a website*” and “*comparing the total number of users to notification criteria of the offline user.*” In an embodiment, the notification criteria specifies a particular number of users that log in to the

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website. "*When the total number of users exceeds a preset amount,*" then a notification is sent to the offline user. The notification informs the offline user of an amount of activity in the website. Claim 1, for example, is reproduced below, and all the other independent claims recite similar features.

1. A method for notifying an offline user, the method comprising the steps of:

monitoring a total number of users who log in to a website;
as each user logs in, comparing the total number of users to notification criteria of the offline user, the notification criteria specifying a particular number of users that log in to the website; and
when the total number of users exceeds a preset amount, then sending a notification to the offline user,

wherein the notification informs the offline user of an amount of activity in the website.

Gudjonsson does not anticipate the claims. No where does *Gudjonsson* disclose such features as recited in claims 1, 7-20, 24-30, 34-40, 42, 44, and 46-48. Examiner Nguyen is correct — *Gudjonsson* provides presence notifications for a buddy list. Yet Examiner Nguyen mistakenly interprets these presence notifications as "*monitoring a total number of users who log in to a website,*" as independent claim 1 recites (and as independent claims 20, 30, 40, 42, and 48 similarly recite). Examiner Nguyen states that *Gudjonsson* "provides each user the ability to monitor the status/presence of a given set of other users." Examiner Nguyen, Final Office Action mailed May 9, 2006, at page 2, paragraph 4 (emphasis added). See also U.S. Patent 6,564,261 to *Gudjonsson et al.* (May 13, 2003) at column 8, lines 61-62. The independent claims, however, do not monitor a "given set of other users" — the independent claims, instead, monitor the "*total number of users who log in to a website.*" Monitoring the "*total number of users who log in to a website*" is entirely different from monitoring the presence of known "buddies." Because the patent to *Gudjonsson et al.* is entirely silent to "*monitoring a total number of users who log in to a website,*" the panel is requested to vacate the final rejection of claims 1, 7-20, 24-30, 34-40, 42, 44, and 46-48.

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Other aspects of Examiner Nguyen's interpretation are mistaken. *Gudjonsson* allows a user to be notified when a buddy's presence or status changes. See U.S. Patent 6,564,261 to Gudjonsson *et al.* (May 13, 2003) at column 8, lines 61-63. Yet Examiner Nguyen mistakenly interprets these presence notifications as "*comparing the total number of users to notification criteria of the offline user,*" as independent claim 1 recites (and as independent claims 20, 30, 40, 42, and 48 similarly recite). The patent to Gudjonsson sends a notification when a known buddy's presence or status changes. Yet no where does *Gudjonsson* disclose sending a notification when "*the total number of users [logged in to the website] exceeds a preset amount.*"

Gudjonsson, then, cannot anticipate the claims. Claims 1, 7-20, 24-30, 34-40, 42, 44, and 46-48 recite, or incorporate, many features that are not disclosed by *Gudjonsson*. Because *Gudjonsson* is silent to many features recited in the claims, the patent to Gudjonsson *et al.* cannot anticipate claims 1, 7-20, 24-30, 34-40, 42, 44, and 46-48. The panel is thus requested to vacate the final rejection of claims 1, 7-20, 24-30, 34-40, 42, 44, and 46-48.

2. The Proposed Combination of *Gudjonsson* with *Payne* or *Gupta* Does Not Teach or Suggest All the Features of the Independent Claims, so the § 103 (a) Rejections are Improper

Claims 3-4, 21-22, 31-32, and 45 were finally rejected under 35 U.S.C. § 103 (a) as being obvious over *Gudjonsson* in view of U.S. Patent 6,021,433 to Payne *et al.* These claims, however, respectively depend from independent claims 1, 20, 30, and 42 and are allowable over the combined teaching of *Gudjonsson* and *Payne* for at least the reasons given above with regard to *Gudjonsson*. The combined teachings of *Gudjonsson* and *Payne* still fails to disclose "*monitoring a total number of users who log in to a website,*" "*comparing the total number of users to notification criteria of the offline user,*" and sending a notification when "*the total number of users exceeds a preset amount,*" as recited in the independent claims. Moreover, the combined teaching of *Gudjonsson* and *Payne* additionally fail to disclose the features recited in

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the dependent claims 3-4, 21-22, 31-32, and 45. Because the proposed combination of *Gudjonsson* and *Payne* fails to disclose all these features, one of ordinary skill in the art would not think that claims 3-4, 21-22, 31-32, and 45 were obvious. The *prima facie* case for obvious must fail, so the panel is respectfully requested to vacate the § 103 rejection.

Claims 5-6, 23, 33, 41, and 43, were finally rejected as being obvious over *Gudjonsson* in view of U.S. Patent 6,763,384 to Gupta *et al.* These claims, however, respectively depend from independent claims 1, 20, 30, and 42 and are allowable over the combined teaching of *Gudjonsson* and *Gupta* for at least the reasons given above with regard to *Gudjonsson*. The combined teaching of *Gudjonsson* and *Gupta* still fails to disclose “monitoring a total number of users who log in to a website,” “comparing the total number of users to notification criteria of the offline user,” and sending a notification when “the total number of users exceeds a preset amount,” as recited in the independent claims. Moreover, the combined teaching of *Gudjonsson* and *Gupta* additionally fail to disclose the features recited in the dependent claims 5-6, 23, 33, 41, and 43. Because the proposed combination of *Gudjonsson* and *Gupta* fails to disclose at least these features, one of ordinary skill in the art would not think that claims 5-6, 23, 33, 41, and 43 were obvious. The *prima facie* case for obvious must fail, so the panel is respectfully requested to vacate the § 103 rejection.

Claims 51-54 were also finally rejected as being obvious over *Gudjonsson* in view of *Gupta*. While *Gupta* describes a high-bid notification for an auction, the proposed combination of *Gudjonsson* and *Gupta* still fails to disclose many features recited by, or incorporated into, claims 51-54. As the above paragraphs explained with regard to *Gudjonsson*, the combined teaching of *Gudjonsson* and *Gupta* still fails to disclose “monitoring a total number of users who log in to the auction website” and “comparing the total number of logged in users to the [notification] conditions,” as recited by independent claim 51. While the proposed combination of *Gudjonsson* and *Gupta* teaches high-bid notifications for known “buddies,” this teaching is entirely different from “monitoring a total number of users who log in to the auction website” and “comparing the total number of logged in users to the [notification] conditions.” Because the proposed combination of *Gudjonsson* and *Gupta* fails to disclose at least these features, one

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of ordinary skill in the art would not think that claims 51-54 were obvious. The *prima facie* case for obvious must fail, so the panel is respectfully requested to vacate the § 103 rejection.

3. Because No "Teaching, Suggestion, or Motivation" was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner has failed to properly make a *prima facie* case for obviousness. The Examiner's *prima facie* case for obviousness must include "some teaching, suggestion, or motivation" to combine prior art that is found "either in the references themselves or in the knowledge generally available to one of ordinary skill." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). Here, however, the Examiner's *prima facie* cases fail to include any teaching, suggestion, or motivation. Examiner Nguyen cites no passage from *Gudjonsson*, *Payne*, or *Gupta* to support the *prima facie* burden. Examiner Nguyen also fails to assert anything found in the knowledge generally available to one of ordinary skill. The *prima facie* cases for obviousness, then, are at least improper for failing to provide any teaching, suggestion, or motivation to combine, as M.P.E.P. § 2143 requires. The Assignee thus respectfully asserts that the § 103 (a) rejections of the pending claims should be removed on appeal.

4. Because No Reasonable Expectation of Success was Cited, the § 103 (a) *Prima Facie* Case for Obviousness Is Improper

The Examiner's *prima facie* case for obviousness is defective for another reason. The Examiner's *prima facie* case for obviousness must include "a reasonable expectation of success." DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner's *prima facie* cases wholly fail to include any expectation of success. The Examiner, then, has failed to carry the burden, so the *prima facie* cases for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejection of the pending claims should be vacated.